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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85892299
Applicant	Michael D Mathes
Applied for Mark	SOUTH BEACH SWIMWEAR
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IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant/Appellant: Michael D. Mathes
Serial No.: **85/892,299**
Filing Date: April 1, 2013
Mark: SOUTH BEACH SWIMWEAR AND DESIGN
Law Office: 105
Examining Attorney: Simon Teng

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Commissioner for Trademarks
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APPLICANT'S REPLY BRIEF

Applicant, Michael D. Mathes ("Applicant") through his undersigned counsel replies to the Examiner's Appeal Brief filed September 17, 2014, in the ex parte appeal of the refusal to register Application Serial No. 85/892,299 for the mark SOUTH BEACH SWIMWEAR AND DESIGN ("Applicant's Mark"). Applicant respectfully objects to the Examiner's failure to consider the admitted dissimilarities of the marks (when considered without dissection), the admitted differences in the channels of distribution, as well as the effect of the exclusionary language included in Applicant's description of goods and services. Applicant files this reply in further support of his appeal as follows:

I. Applicant's Mark is not Confusingly Similar to the Cited application

In his appeal brief, Applicant has shown, without persuasive rebuttal, that the subject marks are completely different in visual and mental impression as well as phonetically. Although the Examiner, in his response brief, states that he recognizes the existence and applicability of the anti-dissection rule, the Examiner does nothing but dissect the Applicant's mark in reaching his conclusion. Indeed, the Examiner breaks apart the words South Beach from the words Swimwear, the design from the words, the words South Beach from the words Food and Wine Festival and more. Contrary to what the Examiner argues, the presence of "WINE & FOOD FESTIVAL" in registrant's mark does diminish the overall similarities of both marks because such wording immediately conveys to consumers that registrant's products are sold at or in

connection with a social event, namely, festivals about wine and food.

As the Examiner admits, Marks must be considered in their entirety, and all components must be given appropriate weight, not just those components that are of a particular interest. In *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F. 3d 1373, 1375 (Fed. Cir. 1998), the Federal Circuit affirmed the Board's finding that confusion between CRISTAL and CRYSTAL CREEK was unlikely, despite the fact that the goods were similar, "wine and champagne," traveled in the same trade channels, and were purchased by the same consumers, because the marks were dissimilar with respect to appearance, sound, significance, and commercial impression. Courts have previously decided that adding certain variations to specific terms defeats likelihood of confusion. Here, although the dominant portion of the mark is SOUTH BEACH, adding SWIMWEAR, even though it is a descriptive term, destroys any possibility of likelihood of confusion, particularly where the remainder of the Registrant's mark describes a wine and food festival. *In re Hearst Corp.*, 25 U.S.P.Q. 2d 1238, 1239 (Fed. Cir. 1992).

Applicant's products specifically target consumers interested in swimwear and nothing else. These consumers are considered to be detail oriented consumers looking for swimsuits; as opposed to Registrant's consumers who are interested in t-shirts, aprons and the like in connection with a festival that happens once a year. Applicant's consumers will not expect to find Applicant's goods in a food related event and vice versa. Registrant's customers will not expect to find Registrant's goods at Applicant's distribution channels.

The Examiner concludes that because some retailers have decided to incorporate swimwear into their line of products, and sell together with other articles of clothing, everyone who sells swimwear and swimsuits will also sell other articles of clothing. This argument is flawed. The fact that some retailers incorporate swimwear into their line of goods is not evidence that Applicant's goods are closely related to those of Registrant. Also, the Examiner is primarily citing to famous retail department type stores that sell everything from clothing to sporting gear to lingerie, all under the same roof. Applicant only sells swimwear and swimsuits and has limited his application as such, therefore eliminating any possibility of present or future confusion. Here, the Registrant does not sell or market for sale swimwear, and does not have a trademark

application or registration covering those goods. Therefore, here, there is no likelihood of confusion between Applicant's goods and Registrant's goods; even though these kinds of goods can be sold by a specific retailer in the same store, there is no requirement that these goods have to be sold together as related goods. Moreover, given the channels of distribution and the fact that Applicant manufactures swimwear and the Registrant runs a once annual wine and food festival, the likelihood of confusion is non-existent and therefore Applicant's mark should be entitled to registration.

The term SOUTH BEACH is weak, diluted, and so widely used that it should not be afforded a broad scope of protection. The examiner states in his argument that "the weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods." Applicant has submitted with his appeal brief copies of third party registrations that do establish, contrary to what the Examiner states, that the registered marks identified therein are in *actual use* in the marketplace or that consumers are accustomed to seeing them as these are all live registrations. Notwithstanding, here are some of the websites for those cited registrations in which the goods are sold: <http://www.southbeachties.com/store/TOTM.htm> ;

<http://www.everythingbutwater.com/browse/products/debbie-katz-south-beach/cottons/46690+1360-sahara.html>

II. Amendment to Identification of Goods and Limitation to Trade Channels

A. Identification of Goods

The Examiner is concerned that Applicant did not limit his description of goods and services for "swimsuits" as well as he did for "swimwear". Although the limitation clearly applies to both, Applicant is willing to further amend his application to the following: "*Swimsuits excluding T-shirts, polo shirts, tank tops, hats, visors, aprons; Swimwear excluding T-shirts, polo shirts, tank tops, hats, visors, aprons.*" This way, the exclusionary language unequivocally applies to swimwear and swimsuits.

B. Channels of Trade

As the Examiner has conceded in his argument, "The presence of "WINE & FOOD FESTIVAL" in Registrant's mark . . . immediately conveys to consumers that registrant's products are sold at a social event, namely, festivals about wine and food." It is clear that the Examiner agrees that Registrant's and Applicant's goods are so different that no one will assume that the goods originate from the same source. The goods are so different that it is obvious that the products will not be sitting or sold next to each other in a store or at the festival, and as such there can be no confusion.

The examiner also points out that it is highly unlikely that consumers are aware of the exclusion in Applicant's identification of goods. This point is a red herring because such knowledge would only be relevant if consumers are ever faced with seeing Applicant's goods together with Registrant's goods. Applicant has already stated that Applicant's trade channels are limited to a person by person basis. Registrant's trade channels are sales via the festival event and through one unaffiliated website, neither of which sells swimwear. The consumers buying Applicant's product will look for swimwear or swimsuits, whereas consumers looking to buy Registrant's goods will look for t-shirts, aprons, sweaters and tank tops as shown in Applicant's brief, Exhibit A. Because Applicant does not advertise or sell his goods via the Registrant's website or at the Registrant's annual festival, their goods are not likely to be found in close proximity of each other. This Board has recently ruled in *In re Bentley Motors Ltd.*, Serial No. 85325994 (December 3, 2013), that there was no likelihood of confusion with the marks BENTLEY, BENTLEY UNIVERSITY, and BENTLEY ORGANIC for *similar or identical goods*. Applicant Bentley Motors successfully argued that, because its goods are sold only through the "very tightly-knit" Bentley circle of dealers and service outlets, to a "niche, affluent clientele," confusion is unlikely and this Board agreed. This case is like the *Bentley* case because Applicant's goods are only sold on a person by person basis and not found in the website Registrant's goods are sold and as such will not cross paths as far as the channels of distribution.

III. Conclusion

For the reasons set forth in detail above, the refusal of registration based on a likelihood of confusion should be reversed and the amendments requested made of record in Applicant's application. Applicant respectfully requests allowance of the present application for publication.

Dated: October 6, 2014

Respectfully submitted,

s/Steven E. Eisenberg/
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